

REMARKS

Upon entry of this amendment, claims 1-3, 6-12, 17-22, 25-31 and 36-46 are all the claims pending in the application. Claims 31-46 are added as new claims. No new matter has been added.

I. Claim Rejections under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 2, 25-31 and 36-40 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Regarding this rejection, however, Applicants note that the Examiner has not pointed to any specific language in the claims that is unclear.

Applicants respectfully submit claims 2, 25-31 and 36-40 satisfy the requirements of 35 U.S.C. § 112, second paragraph, and therefore, kindly request that the rejection be reconsidered and withdrawn. If the Examiner maintains this rejection, Applicants request that the Examiner explicitly identify the language in the claims which the Examiner believes renders the claims indefinite.

II. Claim Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-3, 10-12, 17-22, 29-31, 36, 39 and 40 under 35 U.S.C. § 102(e) as being anticipated by Charm et al. (U.S. 5,985,675).

Claims 1 and 2 recite that the amount of inspection target solution which flows into a cavity part is regulated by a volume of the cavity part. Applicants respectfully submit that Charm does not disclose or suggest such a feature.

Regarding Charm, Applicants note that this reference discloses an analyte test device 10 which includes a housing 12 formed of a one-piece, injected-molded polymer and a test strip 28 (see Fig. 1). As shown in Fig. 1, the housing 12 of Charm defines an elongated cavity 14 with an open end 16 (see col. 4, lines 64-67).

As explained in Charm, the test strip 28 includes a backing strip 30 having a sponge pad 32 formed at a far end thereof (see Fig. 1). Upon application of a sample liquid to the sponge pad 32, the sponge pad 32 absorbs the sample liquid so as to expand within the expansion cavity 18 (see col. 5, lines 17-20 and Fig. 4).

Thus, in Charm, because the sponge pad 32 is the material which is responsible for absorbing and holding the sample liquid upon the application of the sample liquid to the sponge pad 32, Applicants respectfully submit that the amount of sample liquid is regulated by the sponge pad 32.

As such, Applicants respectfully submit that Charm does not disclose or suggest that the amount of inspection target solution which flows into a cavity part is regulated by a volume of the cavity part, as recited in claims 1 and 2. Instead, as noted above, in Charm, the sponge pad 32 is responsible for regulating the amount of sample liquid.

In view of the foregoing, Applicants submit that claims 1 and 2 are patentable over Charm, an indication of which is kindly requested. Claims 3, 10-12 and 17-21 depend from claim 1, and claims 22, 29-31, 36, 39 and 40 depend from claim 2. Accordingly, Applicants submit that these claims are patentable at least by virtue of their dependency.

III. Claim Rejection under 35 U.S.C. § 103(a)

A. The Examiner has rejected claims 6 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Charm in view of Bernstein et al. (U.S. 5,824,268).

Claim 6 depends from claim 1, and claim 25 depends from claim 2. Applicants respectfully submit that Bernstein fails to cure the deficiencies of Charm, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 6 and 25 are patentable at least by virtue of their dependency.

B. The Examiner has rejected claims 7 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Charm in view of Killeen et al. (U.S. 5,166,051).

Claim 7 depends from claim 1, and claim 26 depends from claim 2. Applicants respectfully submit that Killeen fails to cure the deficiencies of Charm, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 7 and 26 are patentable at least by virtue of their dependency.

C. The Examiner has rejected claims 8 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Charm in view of Barr (U.S. 4,252,538). Claim 8 depends from claim 1, and claim 27 depends from claim 2. Applicants respectfully submit that Barr fails to cure the deficiencies of Charm, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claim 8 and 27 are patentable at least by virtue of their dependency.

D. The Examiner has rejected claims 9 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Charm in view of Allen et al. (U.S. 5,426,000).

Regarding claims 9 and 28, Applicants note claim 9 depends from claim 1 and that claim 28 depends from claim 2. Applicants respectfully submit that Allen fails to cure the deficiencies of Charm, as discussed above, with respect to claims 1 and 2. Accordingly, Applicants submits that claims 9 and 28 are patentable at least by virtue of their dependency.

IV. New Claims

Claims 41-46 have been added as new claims. Claims 41-43 depend from claim 1, and claims 44-46 depend from claim 2. Accordingly, Applicants submit that claims 41-46 are patentable at least by virtue of their dependency.

In addition, it is noted that claims 41 and 44 each recite that the cavity part is maintained as an empty space when the inspection target solution flows into said cavity part by a capillary phenomenon.

As discussed above, in Charm, as the liquid sample flows into the expansion cavity 18, the sponge material 32 expands so as to contact the upper surface of the expansion cavity 18 (see Figs. 2-4 and col. 5, lines 57-60). Accordingly, as the sponge material 32 expands so as to contact the upper surface of the expansion cavity 18 while the liquid sample flows into the cavity, it is clear that the cavity 18 is not maintained as an empty space when the liquid sample flows into the cavity.

Applicants respectfully submit that the remaining prior art references cited by the Examiner in the Office Action do not cure the above-noted deficiencies in Charm with respect to

new claims 41 and 44. As such, Applicants respectfully submit that the cited prior art references do not disclose, suggest or otherwise render obvious the above-noted feature recited in claims 41 and 44. Accordingly, Applicants submit that claims 41 and 44 are patentable over the cited prior art, an indication of which is kindly requested.

Further, regarding claims 42 and 45, it is noted that each of these claims recites that a portion of the development layer, other than a portion of the development layer facing the cavity party, is adherently covered by a liquid-impermeable material.

In Charm, a housing 12 is provided covers the entire test strip 28 so as to form the elongated cavity 14 within the housing 12 (see Fig. 1 and col. 4, lines 64-67). Thus, as clearly shown in Fig. 2 of Charm, the elongated cavity 14 is formed between the housing 12 and the test strip 28 along the entire length of the test strip. Accordingly, the housing 12 is separated from the test strip 28 throughout the entire length of the test strip 28.

As such, Applicants respectfully submit that Charm clearly does not or suggest that a portion of the test strip 28 is adherently covered by a liquid-impermeable material. Further, Applicants submit that the remaining prior art references cited by the Examiner do not cure this deficiency of Charm.

Accordingly, Applicants respectfully submit that the cited prior art references do not disclose, suggest or otherwise render obvious the above-noted feature recited in claims 42 and 45. Thus, Applicants submit that claims 42 and 45 are patentable over the cited prior art, an indication of which is kindly requested.

Regarding claims 43 and 46, it is noted that each of these claims recites that the development layer is disposed so that only a portion of the development layer is able to contact

an externally located inspection target solution, the portion of the development layer which is able to contact the externally located inspection target solution facing the cavity part.

As noted above, in Charm, the housing 12 covers the entire test strip 28 so as to form the elongated cavity 14 within the housing 12 (see Fig. 1 and col. 4, lines 64-67). Accordingly, the housing 12 is separated from the test strip 28 throughout the entire length of the test strip 28. Due to this separation between the test strip 28 and the housing 12 throughout the entire length of the test strip 28, Applicants respectfully submit that Charm does not disclose or suggest the above-noted feature recited in new claims 43 and 46. Further, Applicants respectfully submit that the remaining prior art references cited by the Examiner do not cure this deficiency of Charm.

Accordingly, Applicants respectfully submit that the cited prior art references do not disclose, suggest or otherwise render obvious the above-noted feature recited in claims 43 and 46. Thus, Applicants submit that claims 43 and 46 are patentable over the cited prior art, an indication of which is kindly requested.

V. Double Patenting Rejection

Claims 1-3, 6-12, 17-22, 25-31 and 36-40 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/069,845 in view of Charm et al. (U.S. 5,985,675). Applicants note that the Examiner also identifies Application Nos. 10/133,698, 10/398,711, 10/048,727, 10/116,407 and 10/242,672 and asserts that these applications would also require

similar provisional obviousness-type double patenting rejections as set forth for Application No. 10/069,845.

As the above-noted rejection of claims 1-3, 6-12, 17-22, 25-31 and 36-40 under obviousness-type double patenting is provisional, Applicants hereby request that the rejection be held in abeyance. If the provisional double patenting rejection is the only remaining rejection in the application, Applicants will file a terminal disclaimer, if necessary, to overcome such a rejection. See MPEP 804(I)(B).

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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